

### Remarks

Claim 134 has been added. Claim 131 has been amended. Claims 1 to 130 have been cancelled without prejudice or disclaimer. Claims 131 to 134 are pending and under consideration.

Support for the amendment to claim 131 is found in the originally filed specification, e.g., at pages 39 to 42. Support for new claim 134 is found in the originally filed specification, e.g., at pages 39 to 42.

Thus the claims are fully supported by the specification and add no new matter.

Applicant seeks to clarify the Examiner's interpretation of the term "mobility modifier" that appears on page 3, at item 5. First, the Examiner appears to be construing the term "sequence-specific mobility-modifier." Second, the Examiner defines the term "mobility modifier" as nucleic acids "which differ either in their length, or in the label that is attached to them." See page 3, item 5. In fact, the claim actually recites "at least two different sequence-specific mobility-modifiers, wherein each different mobility-modifier is capable of sequence specific binding to a different addressable support-specific portion and comprises (a) a tag complement for specifically binding the addressable support-specific portion of one of the plurality of different amplification products, and (b) a tail which imparts to each mobility modifier a mobility that is distinctive relative to the mobilities of one or more of the at least two different mobility-modifiers in a mobility-dependent analysis technique." Therefore, the language of the claim encompasses nucleic acids "which differ either in their length, or in the label that is attached to them" as suggested by the Examiner, but is not limited to such embodiments. As a non-limiting example, the specification describes a mobility

modifier that comprises a polymer. See, e.g., page 54, lines 1 to 2. Thus, the claim language encompasses more than the embodiments discussed by the Examiner.

### **Rejection in View of Halminen**

The Examiner rejected claims 131 to 133 under 35 U.S.C. § 102(b) as allegedly being anticipated by Halminen et al., *Cytokine*, 11(1):87-93 (January 1999) ("Halminen"). See the November Action at page 4, item 7. Claim 131 has been amended to include the language "wherein the first primer specific portion is the same for each different amplification product." Applicant asserts that Halminen does not show the composition of claim 131, including the element "wherein the first primer specific portion is the same for each different amplification product." Therefore, Halminen fails to anticipate claim 131.

Additionally, claims 132 and 133 depend from claim 131. Thus, for at least the reasons discussed above for claim 131, Halminen fails to anticipate those dependent claims under § 102(b).

Because Halminen does not anticipate claims 131 to 133 for at least the reasons discussed above, applicant need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, applicant in no way acquiesces to those contentions.

Furthermore, applicant asserts that new claim 134 is not anticipated by Halminen.

Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection in view of Halminen.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

### **Rejection in View of Wittwer**

The Examiner rejected claims 131 to 133 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,140,054 ("Wittwer"). See November Action at page 5, item 8. As described above, claim 131 has been amended to include the language "wherein the first primer specific portion is the same for each different amplification product." Applicant asserts that Wittwer does not show the composition of claim 131, including the element "wherein the first primer specific portion is the same for each different amplification product." Therefore, Wittwer fails to anticipate claim 131.

Additionally, claims 132 and 133 depend from claim 131. Thus, for at least the reasons discussed above for claim 131, Wittwer fails to anticipate those dependent claims under § 102(e).

Because Wittwer does not anticipate claims 131 to 133 for at least the reasons discussed above, applicant need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, applicant in no way acquiesces to those contentions.

Furthermore, applicant asserts that new claim 134 is not anticipated by Wittwer.

Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection in view of Wittwer.

### **Rejection in View of Grossman**

The Examiner also rejected claims 131 to 133 under 35 U.S.C. § 102(b) as allegedly being anticipated by Grossman et al., *Nucleic Acids Research*, 22(21):4527-4534, (1994) ("Grossman"). See November Action at page 7, item 9. As described above, claim 131 has been amended to include the language "wherein the first primer

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

specific portion is the same for each different amplification product." Applicant asserts that Grossman does not show the composition of claim 131, including the element "wherein the first primer specific portion is the same for each different amplification product." Therefore, Grossman fails to anticipate claim 131.

Additionally, claims 132 and 133 depend from claim 131. Thus, for at least the reasons discussed above for claim 131, Grossman fails to anticipate those dependent claims under § 102(b).

Because Grossman does not anticipate claims 131 to 133 for at least the reasons discussed above, applicant need not address the Examiner's contentions concerning other elements of those claims. By not addressing those contentions, applicant in no way acquiesces to those contentions.

Furthermore, applicant asserts that new claim 134 is not anticipated by Grossman.

Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection in view of Grossman.

### **Conclusion**

Applicant respectfully asserts that the application is in condition for allowance and requests issuance of a Notice of Allowance. If the Examiner does not consider the application to be in condition for allowance, applicant requests that he call the undersigned at (650) 849-6620 to set up an interview.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 5, 2004

By: 

M. Paul Barker  
Reg. No. 32,013

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)